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CONNOLLY BOVE LODGE & HUTZ, LLP			GEHMAN, BRYON P	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/659,810
Filing Date: September 11, 2003
Appellant(s): FATH ET AL.

Richard M. Beck
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 21, 2005 appealing from the
Office action mailed June 13, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2,888,132	GUYER	5-1959
5,158,178	COBLER	10-1992
192,883	SWIFT	7-1877
3,276,574	MEYERS	10-1966
4,932,534	FOCKE ET AL	6-1990

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 through 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Guyer (2,888,132) in view of either one of Swift (192,883) and Meyers (3,276,574), and further in view of Focke et al. (4,932,534). Guyer disclose a ten pack carton blank

(Figure 4) for packaging ten packs in two rows with five packs in each row in side-to-side abutting relationship with one another, the blank including front (10), rear (12), top (11), bottom (13) and side wall structure, perforated score lines (parts of 33) for separating an assembled ten pack carton into smaller multi-pack retail units, each smaller multi-pack retail unit having an open end exposing the packs therein. To provide wall structure totally enclosing the packs would require elimination of apertures 31 and 32, another obvious elimination of parts and their function. Swift and Meyers each disclose providing a divisible carton structure wherein the carton structure is divisible into various combinations. To modify the structure of Guyer employing the variously divisible carton teaching of either one of Swift and Meyers would have been obvious in order to provide desired numbers of sub-cartons, as suggested by either one of Swift and Meyers. Focke et al. disclose an adhesive dot (97) securing each pack within a carton (see Figures 23 and 24, and column 6, lines 31-37). To modify the prior art further employing the adhesive dot teaching of Focke et al. would have been obvious in order to secure each of the packs within the carton, as suggested by Focke et al..

Claims 1 through 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cobler (5,158,178) in view of either one of Swift and Meyers, and further in view of Focke et al. (4,932,534). Cobler discloses a ten pack carton blank (Figure 7) for packaging ten packs in two rows with five packs in each row in side-to-side abutting relationship with one another, the blank including front (222), rear (224), top (234, 236), bottom (220) and side wall structure, perforated score lines (250, 254, 258) for

Art Unit: 3728

separating an assembled ten pack carton into smaller multi-pack retail units, each smaller multi-pack retail unit having an open end exposing the packs therein. To provide a complete side-by-side abutting relationship of the packs would require elimination of the dividers (214 and 216), an obvious elimination of parts and their function. Swift and Meyers each disclose providing a divisible carton structure wherein the carton structure is divisible into various combinations. To modify the structure of Cobler employing the variously divisible carton teaching of either one of Swift and Meyers would have been obvious in order to provide desired numbers of sub-cartons, as suggested by either one of Swift and Meyers. Focke et al. disclose an adhesive dot (97) securing each pack within a carton (see Figures 23 and 24, and column 6, lines 31-37). To modify the prior art further employing the adhesive dot teaching of Focke et al. would have been obvious in order to secure each of the packs within the carton, as suggested by Focke et al..

Claims 1, 3, 7 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Guyer (2,888,132) in view of Focke et al. ('534). Guyer discloses a ten pack carton blank (Figure 4) for packaging ten packs in two rows with five packs in each row in side-to-side abutting relationship with one another, the blank including front (10), rear (12), top (11), bottom (13) and side wall structure, perforated score lines (parts of 33) for separating an assembled ten pack carton into smaller multi-pack retail units, each smaller multi-pack retail unit having an open end exposing the packs therein. To provide wall structure totally enclosing the packs would require elimination of apertures

31 and 32, another obvious elimination of parts and their function. Focke et al. disclose an adhesive dot (97) securing each pack within a carton (see Figures 23 and 24, and column 6, lines 31-37). To modify the prior art further employing the adhesive dot teaching of Focke et al. would have been obvious in order to secure each of the packs within the carton, as suggested by Focke et al..

(10) Response to Argument

With respect to the significance that each smaller retail unit having at least one open end, it would appear this feature of the prior art combinations would flow directly from the combination taken as a whole. As shown in Guyer, when going from the configuration of Figure 1 to that of Figure 2, each smaller retail unit has at least one open end exposing its packs therein. While appellants' make the argument that the front, rear, top, bottom and side wall structure totally surround and enclose the packs within the carton, it should be noted that this "significant " feature was only added to the original claims by amendment subsequent to the employment of Guyer as a prior art reference in order to distinguish thereover. This further definition of appellants' structure was not found convincing, as to eliminate the provision of apertures 31 and 32 to eliminate the removal advantages disclosed by Guyer would have been an obvious elimination of a part and its function, the differences between the teachings of the prior art references taken as a whole and the appellants' claimed structure not distinguishing any new and unexpected result. The omission of an element and its function has been

held to be obvious if the function of the element is not desired. *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989). "The claims at issue were directed to a method for inhibiting corrosion on metal surfaces using a composition consisting of epoxy resin, petroleum sulfonate, and hydrocarbon diluent. The claims were rejected over a primary reference which disclosed an anticorrosion composition of epoxy resin, hydrocarbon diluent, and polybasic acid salts wherein said salts were taught to be beneficial when employed in a freshwater environment, in view of secondary references which clearly suggested the addition of petroleum sulfonate to corrosion inhibiting compositions. The Board affirmed the rejection, holding that it would have been obvious to omit the polybasic acid salts of the primary reference where the function attributed to such salt is not desired or required, such as in compositions for providing corrosion resistance in environments which do not encounter fresh water.). See also *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) (Omission of additional framework and axle which served to increase the cargo carrying capacity of prior art mobile fluid carrying unit would have been obvious if this feature was not desired.); and *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (deleting a prior art switch member and thereby eliminating its function was an obvious expedient)". The omission of the removal facilitating apertures and accordingly their content removal advantages is maintained to have been obvious.

Comparing the blank of Cobler in Figures 7 and 8 to the blank of appellants' in Figures 4-6, it is apparent the difference between the two lies in the omission of the separate blank portions 214 and 216 in Cobler to close the open ends in Cobler as

opposed to appellants' desire to provide an open end of the smaller retail units produced. This would be obtained by eliminating the blank portions 214 and 216 from the construction of Cobler. Again, it is maintained by the examiner that to do away with the end closing flaps 214 and 216 in Cobler to provide an open end would have been within the capability of one of ordinary skill in the art, given the teaching of Cobler, and the given that elimination of a part and its function would have been obvious to one of ordinary skill in the art.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

Bryon P. Gehman



Conferees:



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